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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,833	10/17/2003	Gwo S. Swei	3090.1010-000 (D-4164)	9438

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/688,833

Applicant(s)

SWEI ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 17-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/31/04, 5/5/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Applicants have not argued the restriction and therefore this is made final.

The abstract of the disclosure is objected to because it is not limited to a single paragraph. Correction is required. See MPEP § 608.01(b).

Claims 10, 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite because it defines that only one condition selected from  $W_g^0$ ,  $T_{melt}$ , F and P must be satisfied (at least one implies only one) but claim 9 implies that a  $W_g^0$  condition must be satisfied, as well as, satisfying at least one other condition selected from  $T_{melt}$ , F and P. In others words claim 9 implies that (at least) 2 conditions must be satisfied but claim 10 implies that only one condition needs to be satisfied, thus the scope of claim 10 is outside the scope of claim 9.

Claim 10 is also indefinite because the numeric values of “coefficient F” and “criterion P” are the same as that defined in claim 9.

Claim 11 is indefinite because it defines that only one condition selected from  $W_g^0$ ,  $T_{melt}$ , F and P must be satisfied (at least one implies only one) but claim 9 implies that a  $W_g^0$  condition must be satisfied, as well as, satisfying at least one other condition selected from  $T_{melt}$ , F and P. In others words claim 9 implies that (at least) 2 conditions must be satisfied but claim 11 implies that only one condition needs to be satisfied, thus the scope of claim 10 is outside the scope of claim 9

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Claim 16 is indefinite because the examiner is unclear as to how this contact angle is determined. The phrase "that is determined, at least in part, ...composition" renders the scope of the claim unclear because the examiner is unclear as to what this is defining. Said phrase is not defined in clear and concise manner as to enable complete understanding of the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 and 16 are rejected under 35 U.S.C. 120(b) or in the alternative, under 35 U.S.C. 103 (a) as obvious over Peterson (554).

This reference teaches in column 5, lines 14-35 and the claims, an abrasive article comprising a substrate, abrasive particles adhered thereto by a binder and an anti loading agent over the abrasive grains, said anti loading agent comprising a mixture of 2 organic compounds (i.e. a sodium alkyl sulfate and lithium salt of a fatty acid).

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With respect to the first organic compound, the reference teaches that this is a sodium alkyl sulfate and this reads of since sodium lauryl sulfate. Although the claimed criterion is not defined, this is inherent in the material because the sulfate used is the same as in the claimed invention (i.e. an alkyl sulfate).

With respect to the second organic additive, the reference teaches that this is a lithium salt of a fatty acid and this reads on the claimed second organic material because the claims do not exclude this component. All the claims state is that the  $W_g^o$  must be different and thus no distinction is seen to exist because it is the examiners position that the different organic materials have different  $W_g^o$  values absent evidence to the contrary.

In view of the above, the claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary.

Claims 14-15 are rejected under 35 U.S.C. 103 (a) as obvious over Peterson (554).

Sodium lauryl sulfate is obvious because the reference teaches sodium alkyl sulfate and **generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971).**

Claims 9-13 are rejected under 35 U.S.C. 103 (a) as obvious over Gaeta et al. (338).

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This reference teaches in column 2, line 49-column 5, line 2, an abrasive article comprising a substrate, abrasive particles adhered thereto by a binder and an anti loading agent over the abrasive grains, said anti loading agent comprising an organic compound.

With respect to the first organic compound, the reference teaches organic compounds which can be used and although the claimed criterion are not defined, it is the examiners position that the claimed criterion are satisfied absent evidence to the contrary (applicants must show that the reference organic materials do not meet the claimed criterion).

Claims 9-11, 13 and 16 are rejected under 35 U.S.C. 103 (a) as obvious over Law et al. (542).

This reference teaches in the claims, an abrasive article comprising a substrate, abrasive particles adhered thereto by a binder and an anti loading agent over the abrasive grains, said anti loading agent comprising an organic compound according to the formulas defined. Mixtures of anti loading agents can also be used.

With respect to the first organic compound, the reference teaches organic compounds which can be used and although the claimed criterion are not defined, it is the examiners position that the claimed criterion are satisfied absent evidence to the contrary (applicants must show that the reference organic materials do not meet the claimed criterion).

With respect to the second organic additive, the reference teaches that a mixture can be used and this reads on the claimed second organic material because the claims do not exclude this component. All the claims state is that the  $W_g^0$  must be different and thus no distinction is

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seen to exist because it is the examiners position that the different organic materials have different  $W_g^o$  values absent evidence to the contrary.

Claims 9-13 and 16 are rejected under 35 U.S.C. 120(b) or in the alternative, under 35 U.S.C. 103 (a) as obvious over Law et al. (952).

This reference teaches in column 22, line 58, column 32, lines 12-17 and the claims, an abrasive article comprising a substrate, abrasive particles adhered thereto by a binder and an anti loading agent over the abrasive grains, said anti loading agent comprising an organic compound according to the formulas defined. Mixtures of anti loading agents can also be used, as well as, conventional other anti loading agents is admixture.

With respect to the first organic compound, the reference teaches that this is a sodium octadecyl sulfate. Although the claimed criterion is not defined, this is inherent in the material because the sulfate used is the same as in the claimed invention (i.e. sodium alkyl sulfate).

With respect to the second organic additive, the reference teaches that a mixture can be used and this reads on the claimed second organic material because the claims do not exclude this component. All the claims state is that the  $W_g^o$  must be different and thus no distinction is seen to exist because it is the examiners position that the different organic materials have different  $W_g^o$  values absent evidence to the contrary.

In view of the above, the claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary.

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Claim 14 is rejected under 35 U.S.C. 103 (a) as obvious over Law et al. (952).

The reference teaches that this is a sodium alkyl (octadecyl) sulfate and this reads broadly of since sodium decyl sulfate because **a generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971).** Sodium octadecyl sulfate is a sodium decyl sulfate, in the broad sense, and therefore this reads on the claimed material.

Claims 9-16 are rejected under 35 U.S.C. 120(b) or in the alternative, under 35 U.S.C. 103 (a) as obvious over Law et al. (682).

This reference teaches in column 7, lines 15-50 and the claims, an abrasive article comprising a substrate, abrasive particles adhered thereto by a binder and an anti loading agent over the abrasive grains, said anti loading agent comprising a mixture of 2 organic compounds (i.e. a sodium dodecyl sulfate (sodium lauryl sulfate) and another surfactant or other organic material).

With respect to the first organic compound, the reference teaches that this is a sodium dodecyl sulfate and this is sodium lauryl sulfate. Although the claimed criterion is not defined, this is inherent in the material because the sulfate used is the same as in the claimed invention (i.e. both sodium lauryl sulfate).

With respect to the second organic additive, the reference teaches that a mixture can be used and this reads on the claimed second organic material because the claims do not exclude



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this component. All the claims state is that the  $W_g^0$  must be different and thus no distinction is seen to exist because it is the examiners position that the different organic materials have different  $W_g^0$  values absent evidence to the contrary.

In view of the above, the claimed invention is anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary.

Although not a basis for the above 102 rejection, the examiners would like to point to column 7, lines 42+ which defines that the peripheral coating is based on an organic material. This teaching of the reference is applicable in the 103 rejection above because, although the claimed criterion are not defined, it is the examiners position that the claimed criterion are satisfied absent evidence to the contrary (applicants must show hat the reference organic materials do not meet the claimed criterion).

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference

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can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

A generic disclosure renders a claimed species *prima facie* obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971).

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside (i.e. as well as the upper and lower limits) the claimed range to show the criticality of the claimed range. *In re Hill* 284 F.2d 955, 128 USPO 197 (CCPA 1960).

Any foreign language documents submitted by applicant has been considered to the extent of the short explanation of significance, English abstract or English equivalent, if appropriate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

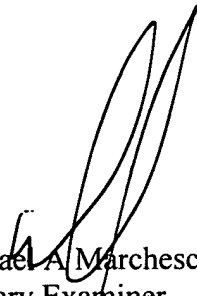
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